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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Darwin He

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BRIARCLIFF MANOR, NY 10510

EXAMINER

SANDERS, STEPHEN

ART UNIT

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4133

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,138	Applicant(s) HE ET AL.	
	Examiner STEPHEN SANDERS	Art Unit 4133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Oct. 27, 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to Application/Control Number: 10/525138 filed on February 16, 2005 in which claims 1-9 are presented for examination.

Status of Claims:

Claims 1-9 are pending, in which claims 1, and 5-9 are in independent form. Objections are made to claims 2-4. Claims 1, 3, and 5-9 are rejected under 35 U.S.C. 112. Claims 1-9 are rejected under 35 U.S.C. 101. Additionally, claims 1-9 are rejected under 35 U.S.C. 102(b).

Claim Objections

1. Claims 2-4 are objected to because of the following informalities: Dependent claims 2-4 improperly recite the limitation "A communication method..." in referring to independent claim 1, in their first lines. It is suggested that their recitation be changed to "The communication method...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claims 1, 3, and 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 3, and 5-9, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1-9, they use the term “data carrier”, which to a person skilled in the art could interpret this term as related to a transmitted electromagnetic signal carrying data. Such a transmitted electromagnetic signal carrying data is not a process, a machine, a manufacture, or a composition of matter. Such a claimed data carrier does not define one of the four statutory categories of inventions that Congress deemed to be appropriate subject matter of a patent, they are rejected under U.S.C. 101 (see MPEP 2106).

Additionally, as to claims 8 and 9, they are directed toward a computer program, which is a computer software program. Such computer software program is not a process, a machine, a manufacture, or a composition of matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer

programs do not define any structural and functionality interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Since claims 8 and 9 are not directed to one of the four statutory categories of inventions that Congress deemed to be appropriate subject matter of a patent, they are rejected under U.S.C. 101 (see MPEP 2106).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nordman, Patent No.: WO 9832301 A1; Publication Date: July 23, 1998 hereinafter Nordman. (Note: Nordman listed references shown in this office action use the column and line numbers from the Patent-Family U.S. Patent Number 6,061,346, Date of Patent May 9, 2000.)

As to claim 1, the following is taught: "A communication method via a network (30) between a recording and/or reproducing device (20) able to read a data carrier (22), and a remote unit (10) comprising additional data (11) for the data carrier (22)," (Nordman teaches: Abstract, column 4, line 54, to column 5, line 17; column 5, lines 41-58);

“said communication method comprising the steps of: extracting data carrier properties (23) from the data carrier (22) inserted in the recording and/or reproducing device (20),” (Nordman teaches: in column 5, line 66, to column 6, line 11 – a WHI identifier, which is a stored authentication identification, equivalent to the data carrier properties);

“sending said properties (23) to the remote unit (10),” (Nordman teaches: column 6, line 12-29); and

“authenticating the data carrier (22) by comparing said properties (23) with the ones of a corresponding data carrier legally produced by a provider, before sending the additional data (11) to the recording and/or reproducing device (20).” (Nordman teaches: column 6, line 55-62); column 7, lines 37-51);

As to claim 2, the following is taught: “A communication method as claimed in claim 1, wherein the data carrier properties (23) are written in a control data zone of the data carrier (22).” (Nordman teaches: Abstract, column 6, lines 5-11);

As to claim 3, the following is taught: “A communication method as claimed in claim 1, further comprising a step of blacklisting the recording and/or reproducing device (20) if the remote unit (10) receives a number of requests higher than a predetermined threshold from said recording and/or reproducing

device (20) containing a non-authenticated data carrier.” (Nordman teaches: column 5, lines 5-22; column 11, lines 9-26).

As to claim 4, the following is taught: “A communication method as claimed in claim 1, wherein the remote unit (10) is able to send different types of additional data (11) as a function of the properties (23) of the data carrier (22).” (Nordman teaches: column 1, lines 11-20; column 4, lines 35-41 and 54-61).

As to claim 5, the following is taught: “A communication system” (Nordman teaches: column 1, line 57 to column 4, line 16; column 6, lines 12-44)

“comprising a recording and/or reproducing device (20) able to read a data carrier (22), and a remote unit (10) comprising additional data (11) for the data carrier (22), said device (20) and unit (10) communicating via a network (30), wherein the remote unit (10) is able to retrieve data carrier properties (23) from the data carrier (22)” (Nordman teaches: Abstract, column 4, line 54, to column 5, line 17; column 5, lines 41-58);

“inserted in the recording and/or reproducing device (20), and” (Nordman teaches: column 5, line 66, to column 6, line 11);

“to authenticate said data carrier (22) by comparing said properties (23) with the ones of a corresponding data carrier legally produced by a provider, before sending the additional data (11) to said recording and/or reproducing device (20).” (Nordman teaches: column 6, line 55-62); column 7, lines 37-51).

As to claim 6, the following is taught: “A remote unit (10)” for communicating with a recording and/or reproducing device (20)” (Nordman teaches: column 1, line 57 to column 4, line 16; column 6, lines 12-44);

“able to read a data carrier (22), the remote unit (10) comprising additional data (11) for the data carrier (22),” (Nordman teaches: Abstract, column 1, lines 11-20; column 4, lines 35-41; column 4, line 54, to column 5, line 17; column 5, lines 41-58);

“means for retrieving data carrier properties (23) from the data carrier (22) inserted in the recording and/or reproducing device (20), and” (Nordman teaches: column 5, line 66, to column 6, line 11);

“means for authenticating said data carrier (22) by comparing said properties (23) with the ones of a corresponding data carrier legally produced by a provider, before sending the additional data (11) to said recording and/or reproducing device (20).” (Nordman teaches: column 6, line 55-62); column 7, lines 37-51).

As to claim 7, the following is taught: “A recording and/or reproducing device (20) able to read a data carrier (22) and to communicate with a remote unit (10)” (Nordman teaches: column 1, line 57 to column 4, line 16; column 6, lines 12-44);

“comprising additional data (11) for the data carrier (22), said device comprising means for extracting data carrier properties (23) from the data carrier (22) inserted in the recording and/or reproducing device (20) and” (Nordman teaches: column 1, lines 11-20; column 4, lines 35-41 and 54-61; column 5, line 66, to column 6, line 11);

“means for sending said properties (23) to the remote unit (10).” (Nordman teaches: column 6, line 12-29).

As to claim 8, the following is taught: “A computer program” (Nordman teaches: column 1, lines 23-28 and 57-65; column 4, lines 4-14 and 43-49; column 6, lines 4-11, 21-24, and 55-62);

“comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network (30) between a recording and/or reproducing device (20) able to read a data carrier (22), and a remote unit (10) comprising additional data (11) for the data carrier (22), said communication method comprising the steps of:” (Nordman teaches: Abstract, column 4, line 54, to column 5, line 17; column 5, lines 41-58);

“extracting data carrier properties (23) from the data carrier (22) inserted in the recording and/or reproducing device (20), and” (Nordman teaches: Abstract, column 4, line 54, to column 5, line 17; column 5, lines 41-58);

“sending said properties (23) to the remote unit (10).” (Nordman teaches: column 6, line 12-29).

As to claim 9, the following is taught: "A computer program" (Nordman teaches: column 1, lines 23-28 and 58-65; column 4, lines 4-14 and 43-49; column 6, lines 21-24 and 55-62);

"comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network (30) between a recording and/or reproducing device (20) able to read a data carrier (22), and a remote unit (10) comprising additional data (11) for the data carrier (22), said communication method comprising the steps of:" (Nordman teaches: Abstract, column 4, line 54, to column 5, line 17; column 5, lines 41-58);

"retrieving data carrier properties (23) from the data carrier (22) inserted in the recording and/or reproducing device (20), and" (Nordman teaches: column 5, line 66, to column 6, line 11);

"authenticating the data carrier (22) by comparing said properties (23) with the ones of a corresponding data carrier legally produced by a provider, before sending the additional data (11) to the recording and/or reproducing device (20)." (Nordman teaches: column 6, line 55-62); column 7, lines 37-51).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Valerij et al, U.S. Patent No.: 5,790,662; Date of Patent: Aug. 4, 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN SANDERS whose telephone number is (571)270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on 571-272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/

/Examiner, Art Unit 4133/

/Frantz Coby/
Supervisory Patent Examiner
Art Unit 4133